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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/855,905	05/14/1997	MASAAKI YAMANAKA	443-17	2320

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EXAMINER
KRUER, KEVIN R

ART UNIT	PAPER NUMBER
1773	39

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A3-39

Office Action Summary	Application No.	Applicant(s)	
	08/855,905	YAMANAKA ET AL.	
	Examiner	Art Unit	
	Kevin R Kruer	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 13, 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20 and 27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20 and 27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

This action is in response to the director's decision with regards to the petition filed May 6, 2003. In compliance with the decision, this action is non-final and Applicant's statutory time period for response has been restarted.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-20 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 states that the paper has a "gloss of 60% or below." Under the precedence set in In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), there is insufficient support for a claim with such an open-ended limitation. Specifically, Applicant has support for one end point of the claimed range (60%) but not for the other (0%).

2. Claims 1-20 and 27 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 claims that the paper has opacity of 83% or above. Under the precedence set in In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), there is insufficient support for a claim with such an open-ended limitation. Specifically, Applicant has support for one end point of the claimed range (83%) but not for the other (100%).

Claim Rejections - 35 USC § 103

1. Claims 1-20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takashi et al. (Pat. No. 4,318,950) in view of European Patent 0 613 919 A1 (herein referred to as Ueda) and Ohba et al. (Pat. No. 5,233,924) for reasons of record.

Response to Arguments

Applicants' arguments filed June 13, 2003, have been fully considered but they are not persuasive.

Applicant argues that it is "clearly seen" from the data in the specification that claimed ranges are supported. Specifically, Applicant argues that the examples show optical properties of gloss from 15-60% and opaqueness of 83-96%. However, Applicant does not have support for the currently claimed endpoints. Specifically, Applicant does not have support in the original disclosure for a gloss of 0% or an opacity of 100%. Thus, the rejection is maintained.

Applicant argues that the composition of Ueda is taught, "to provide an antistatic resin composition with superior permanently antistatic property, mechanical strength, and moldability." Further, Ueda describes "the permanently antistatic property and mechanical strength of molded articles." Applicant argues there is no suggestion to use the resin composition taught in Ueda in a biaxially oriented sheet for use as synthetic paper. However, the rejection never relied upon Ueda for such a teaching or motivation. Rather, the primary reference, Takashi, was relied upon to teach a biaxially oriented polyolefin composition useful as a synthetic paper. Applicant further argues that the resin composition taught in Ueda in the production of synthetic paper taught in Takashi. The examiner points out that the rejection does not suggested that the entire composition of Ueda should be utilized. Rather, the rejection states

that it would have been obvious to utilize the anti-static agent taught in Ueda in the composition taught in Takashi. Furthermore, the examiner disagrees with applicant's conclusion that the teachings of Ueda are limited to molded compositions. Ueda states "the invention relates to a polyetheresteramide with high heat resistance, permanently antistatic property and superior compatibility with thermoplastic resins (see page 2, lines 3+)." Furthermore, Ueda claims a "resin composition" comprising the polyetheresteramide antistatic agent (see claim 5). Thus, it is incorrect for Applicant to suggest the teachings of Ueda are limited to molded compositions.

Applicant further argues that Takashi neither suggests nor motivates use of the high molecular weight antistatic agent taught in Ueda. The rejection, however, never relied upon Takashi for such a teaching. Ueda was relied upon to teach the claimed antistatic agent and to motivate one of ordinary skill in the art to utilize it in the synthetic paper composition taught in Takashi. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has also filed a declaration, by Yamanaka, to further support their position. The Yamanaka declaration analyzes the resistivity and offset printability of a variety of experimental compositions.

In the first experiment, the same procedure as in Example 12 of Takashi was followed. Said example has high surface resistivity and poor offset printability. However, said experiment does not agree in scope with the present claims. Specifically, the claims do not require a 3-layered film. Furthermore, the declaration shows that said composition has high surface

resistivity after washing. Said result is not unexpected in view of the teachings of Ueda. Furthermore, one of ordinary skill in the art would also expect a sheet with high surface resistivity to exhibit poor offset printing (see page 1 of the specification, Background of the Invention).

In a second experiment, the same procedure as in Example 12 of Takashi in which 0.7 parts by weight to polyetheresteramide was utilized in place of low molecular weight antistatic was performed. Said example has high surface resistivity and poor offset printability. However, the second experiment is not representative of a paper rendered obvious by Takashi in view of Ueda. Specifically, Ueda teaches that much higher amounts of polyetheresteramide antistatic is necessary. Furthermore, Ueda teaches that b2 is necessarily present and components C, and D are desirably present. One of ordinary skill in the art would also expect a sheet with high surface resistivity to exhibit poor offset printing (see page 1 of the specification, Background of the Invention).

Yamanaka performed a third experiment in which the same procedure of Example 12 of Takashi was performed except for changing the low molecular weight antistatic agent to 20 parts by weight of polyetheresteramide. Said example has a small effect of improving antistatic properties because of the poor dispersibility of the polyetheresteramide and poor offset printability. However, the third experiment is not representative of a paper rendered obvious by Takashi in view of Ueda. Specifically, Ueda teaches that b2 is necessarily present (see claim 1) and claimed components C, and D are desirably present. One of ordinary skill in the art would also expect a sheet with high surface resistivity to exhibit poor offset printing (see page 1 of the specification, Background of the Invention).

Applicant argues that the high molecular weight antistatic agent of the declaration contains B2, as used in the second supplemental declaration. The examiner disagrees with Applicant's conclusion. The declaration states that the high molecular weight agent is product B1 (see example 2 of the third supplemental declaration). Applicant further states that the high molecular weight agent is polyetheresteramide. The declaration does not indicate that any component other than B1, polyetheresteramide, is present in the high molecular weight agent.

The fourth experiment is an "inventive" example and does not require any analysis.

Yamanaka also attempted to utilize the composition of Ueda under the conditions of Takashi (experiment 5). However, such a combination of the prior art is not proposed in the outstanding rejection. Thus, experiment 5 is not representative of the closest prior art.

Applicant makes an argument with regards to "the assertion that Ueda teaches higher amounts of PEA antistatic agent." The examiner cannot find where that "assertion" was made. Therefore, the examiner cannot fully respond to applicant's concerns.

Thus, Applicant's arguments are not persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday from 7:30a.m. to 4:00p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is 703-305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

K-RK

Kevin Kruer
Patent Examiner

Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700